REMARKS

By this Amendment, Applicants submit an English translation of their Japanese priority application no. 2003-41486 upon which priority under 35 U.S.C. § 119 was claimed thereby perfecting the claim to priority. Applicants also amend claims 1, 19, and 20, and cancel claim 11, without prejudice or disclaimer of the subject matter thereof. Claims 1-10 and 12-20 remain pending.

In the Office Action, the Examiner objected to claims 3, 5-10, 15, and 16 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner rejected claims 1, 2, 4, 12, 14, and 17-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0140051 to Fujiwara et al. ("Fujiwara"); rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara in view of U.S. Patent Application Publication No. 2004/0205109 to Hara et al. ("Hara"); and rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara.[1]

Applicants thank the Examiner for pointing out allowable subject matter in claims 3, 5-10, 15, and 16. Applicants respectfully traverse the Examiner's objection and rejections.

Regarding the rejection under 35 U.S.C. § 102(e)

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, 4, 12, 14, and 17-20 under 35 U.S.C. § 102(e) as being anticipated by Fujiwara. In order to

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1, as amended, recites a combination including, for example, "a second memory to store a weight of the storage apparatus as a performance degree, the weight being calculated by at least one of storage capacity, calculation ability, and circuit speed of the storage apparatus." Fujiwara fails to disclose at least these features of amended claim 1, as recognized by the Examiner in stating "Fujiwara et al. do not teach that *the weight of the storage apparatus is calculated by at least one of storage capacity, calculation ability, and circuit speed of the storage apparatus*." (Office Action at 8, emphasis in original).

However, the Examiner alleges that "Hara et al. disclose in their invention 'Computer System' a distributed file system where the storage of a file into a plurality of storage devices associated with computers is determined by a set of allocation rules taking into consideration the performance, security level, reliability level and utility rate of the storage devices [abstract; figures 1-6 and 8-10]." (Office Action at 8, emphasis in original).

Applicants respectfully disagree. Hara's teaching of device allocation based on performance, security level, reliability level, and utility rate does not constitute "a second memory to store a weight of the storage apparatus as a performance degree, the weight

being calculated by at least one of storage capacity, calculation ability, and circuit speed of the storage apparatus," as recited in amended claim 1 (emphasis added).

Moreover, Applicants have perfected the claim to priority under 35 U.S.C. § 119 by submitting the English translation of their Japanese priority application having a filing date of February 19, 2003. Therefore, with a later U.S. filing date of August 8, 2003, Hara does not qualify as prior art against this application.

Thus, Hara is disqualified as prior art and Fujiwara fails to disclose each and every element of amended claim 1. Fujiwara therefore cannot anticipate amended claim 1 under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request withdrawal of the Section 102(e) rejection of amended claim 1. Because claims 2, 4, 12, 14, 17, and 18 depend from claim 1, either directly or indirectly, Applicants also request withdrawal of the Section 102(e) rejection of these claims for at least the same reasons stated above.

Further, amended independent claims 19 and 20, while of different scope, include similar recitations to those of amended claim 1. Claims 19 and 20 are therefore also allowable for at least the same reasons as stated above with respect to amended claim 1. Accordingly, Applicants respectfully request withdrawal of the Section 102(e) rejection of claims 19 and 20.

Regarding the rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara in view of Hara. However, claim 11 has been canceled, and the Section 103(a) rejection of claim 11 is therefore moot.

Applicants respectfully traverse the Examiner's rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Claim 13 depends from claim 1. As explained above, Fujiwara fails to teach or suggest at least "a second memory to store a weight of the storage apparatus as a performance degree, the weight being calculated by at least one of storage capacity, calculation ability, and circuit speed of the storage apparatus," as recited in amended claim 1 (emphasis added) and required by claim 13.

Therefore, Fujiwara fails to teach or suggest all elements of claim 13. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 13.

Regarding the claim objection

Applicants respectfully traverse the Examiner's objection to claims 3, 5-10, 15, and 16 as being dependent upon a rejected base claim. As set forth above, the base claim, amended claim 1, is allowable over the applied references. Therefore, claims 3,

5-10, 15, and 16 are also allowable. Accordingly, Applicants respectfully request withdrawal of the objection to claims 3, 5-10, 15, and 16.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 3, 2007

By: _____
Wenye Tan
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Attachments: **a certified English Translation of Japanese priority application no. 2003-41486.**